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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,792	01/15/2002	W Thomas Urmson, Jr.	2046-011632	7034

7590 10/09/2003

Paul M. Reznick
700 Koppers building
436 Seventh Avenue
Pittsburgh, PA 15219-1818

EXAMINER

MCANULTY, TIMOTHY P

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,792

Applicant(s)

URMSON, JR. ET AL.

Examiner

Timothy P McAnulty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The corrected or substitute drawings were received on 08 August 2003. These drawings are accepted.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1,2,5,7-10,12-17,19-23,27, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Watts.

Watts discloses in figures 1-3 an applicator bar for applying a material to a head of a rail comprising a body 3 having a flow passageway therein, said flow passageway defining an exit 5; a dam sealed by an elastomeric member 17 and said body 3; a metal distribution blade 8; and a flexible skirt 9, enclosing an upper portion of said dam. Watts further discloses in lines 10-29, a pump and reservoir in fluid communication with said flow passageway.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watts.

Watts discloses the basic apparatus as previously cited but does not disclose said dam comprising a D-shaped seal, however, forming the body of Watts to be D-shaped so as to seal said dam is one of numerous configurations a person of ordinary skill in the art would find

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obvious for the purpose of sealing said dam. See *Graham v. John Deere Co.*, 38 U.S. 1, 148 USPQ 459 and *In re Dailey*, 149 USPQ 47 (CCPA 1976).

6. Claims 4, 11, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watts in view of Huck (US Patent No. 2,489,182).

Regarding claims 4 and 11, Watts discloses the basic apparatus as previously cited but does not disclose said skirt made from an elastomeric material. However, Huck teaches in figure 1 and lines 23-64 of column 3, a railway track lubricating device comprising a flexible skirt member B made from an elastomeric material. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Watts in view of the teachings of Huck to include a skirt made from an elastomeric material to provide a skirt having increased resiliency.

Regarding claim 18, Watts discloses the basic apparatus as previously cited but does not disclose said skirt position over a portion of the upper surface of said rail. However, Huck in figure 1, teaches a railway track lubricating device comprising a flexible skirt position over a portion of the upper surface of a rail. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Watts in view of the teachings of Huck to position said skirt over a portion of the upper surface of a rail so as to provide an increased amount of lubrication material to an upper surface of said rail.

Response to Arguments

7. Applicant's arguments filed 08 August 2003 have been fully considered but they are not persuasive. Watts clearly discloses a wayside applicator as now required by the amendments to the claims.

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Regarding claims 1-2327, and 28, as broadly claimed, Watts discloses a dam which contains the material with an outside surface of the head of the rail and wherein the dam terminates at a crown of the head of the rail. The limitation "an outside surface of the head" is merely limited to any outer surface of the head of the rail. Also, the flexible skirt of Watts enclosing the upper portion of the dam therein terminates at a crown of the head of the rail and inherently directs the material to the crown of the rail.


Additionally, specifically regarding claims 1-8, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138 (CCPA 1946). Claim 1 in line 4 contains such a recitation.

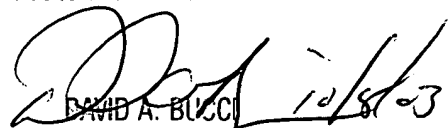
Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy P McAnulty whose telephone number is 703.308.8684. The examiner can normally be reached on Monday-Friday (7:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703.308.3668. The fax phone numbers for the organization where this application or proceeding is assigned are 703.872.9326 for regular communications and 703.872.9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.1113.

tpm 
October 8, 2003


DAVID A. BUCCI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600